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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,531	07/25/2003	Kouichi Sugiyama	00862.023142	1149

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EXAMINER	
ROGERS, SCOTT A	
ART UNIT	**PAPER NUMBER**
2625	
MAIL DATE	**DELIVERY MODE**
06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/626,531	SUGIYAMA ET AL.	
	Examiner	Art Unit	
	Scott A. Rogers	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/22/06 & 11/8/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *Detailed Action (p. 2-7)*.

DETAILED ACTION

Election/Restrictions

The examiner made a restriction requirement by telephone to one of the following related inventions under 35 U.S.C. 121:

I. Claims 1, 3-4, 6, 8-9, 11, and 13-14 are drawn to appending mirror image designation information to rendering contents to be printed as part of a generated print job when the designated print medium is transparent.

II. Claims 2, 5, 7, 10, 12, and 15 are drawn to converting rendering contents to be printed into rendering contents of a mirror image from which a print job is generated when the designated print medium is transparent.

In a telephone response from Scott D. Malpede on 15 March 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 3-4, 6, 8-9, 11, and 13-14. However, upon examination of the elected claims, it was found that while the related invention of Group II, claims 2, 5, 7, 10, 12, and 15, has a different mode of operation and scope, the inventions as claimed are in fact obvious variants. Therefore the restriction requirement is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshihiro (JP6278315).

Toshihiro discloses checking a designated print medium 20, converting rendering contents to be printed into rendering contents of a mirror image when it is determined that the designated print medium is a transparent medium, and generating a print job on the basis of the rendering contents of the mirror image, and outputting the print job to be transmitted to the printer 8. See abstract.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4-6, 9-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshihiro as applied to claims 2, 7, and 12 above, and further in view of Takashi (JP5012388).

Toshihiro does not disclose appending mirror image designation information to rendering contents to be printed when it is determined that the designated print medium is a transparent medium, and generating a print job to be transmitted to the printer on the basis of the rendering contents to be printed and the mirror image designation

information. Nor does Toshihiro disclose acquiring device information of the printer and if the printer has a mirror image flip print function, appending the mirror image designation information to the rendering contents to be printed when it is determined that the print medium is a transparent medium.

However, Takashi teaches the idea of reducing the data processing load on the image processor by putting an output device (printer) in partial charge of data processing when the connected output device has a function to perform that processing. Moreover, Takashi provides output device (printer) function information about what processing the device can perform.

It would have been obvious to one of ordinary skill in the art to have modified Toshihiro in view of Takashi to have provided a mode for appending mirror image designation information to rendering contents to be printed and and generating a print job to be transmitted to the printer on the basis of the rendering contents to be printed and the mirror image designation information when it has been determined that the connected printer has a mirror image flip print function and the designated print medium is a transparent medium. Such a modification would have reduced the data processing load on the image processor of Toshihiro as taught by Takashi.

Claims 3, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshihiro and Takashi as applied to claims 1, 6, and 11 above, and further in view of well known prior art (Official Notice).

Neither Toshihiro nor Takashi disclose making a user designate whether or not a mirror image flip print process is to be executed when a print medium is a transparent

medium, and thereby checking a print medium when the mirror image flip print process is designated is to be executed by the user when a print medium is a transparent medium.

However, providing for user control over various print processes to be performed is natoriously old and well known in the art. It would therefore have been obvious to one of ordinary skill in the art, in view of such well known prior art, to have modified the combination of Toshihiro and Takashi to have further included user control over print processing including the designation of a mirror image flip print process to be executed when a transparent print medium is detected in the printer. Such a modification would allow a user to control what print processes are executed, such as a mirror image flip print process, whereby such processes can be prevented when not desired no matter what other conditions apply.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

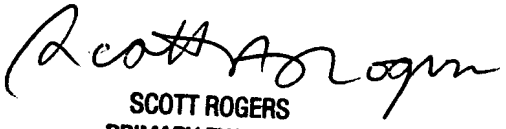
Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 10-12 define a program for making a computer to transmit a print job embodying functional descriptive material. However, the claims do not define a computer-readable medium or memory and are thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests alternatively amending the claim to embody a program (rather than a system in this case) on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Rogers whose telephone number is 571-272-7467. The examiner can normally be reached Monday through Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached at 571-272-7402.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service at 571-272-2600. Official correspondence by facsimile should be sent to 571-273-8300. The USPTO contact Center phone numbers are 800-PTO-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCOTT ROGERS
PRIMARY EXAMINER

28 May 2007